

REMARKS

The foregoing amendment and the following arguments are provided generally to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Claims 1, 4-16, 19-27 and 29-73 are pending in this application. Claims 1, 4-16 and 19-27 have been rejected. Claims 29-73 have been previously withdrawn from consideration. In this response, claims 1, 4-12, 19-21, 23-27 have been amended. Claims 74-95 have been newly added. No new matter has been added. Support for the newly added claims can be found in the specification and drawings.

Reconsideration and withdrawal of the rejections set forth in the Office Action dated May 29, 2008, are respectfully requested in view of the remarks below.

Interview Summary Statement

A telephonic interview was conducted between Examiner Michael Misiaszek, and applicant's representative, Yenyun Fu. The undersigned representative wishes to thank Examiner Misiaszek for the telephonic interview conducted on July 17, 2008.

During the interview, the proposed amendments to independent claim 1, reference Berarducci, et al. (U.S. Pub. No.: 2005/0225799), and reference Mauro, et al. (U.S. Pub. No.: 2003/0200099), were discussed.

Examiner Misiaszek recommended that applicant emphasize that the predetermined user-selected image processing settings are intended for use to modify a digital image as opposed to a physical print image to overcome the Mauro reference. The Examiner also requested further clarification and elaboration on some aspects of the recited language in claim 1. Such incorporations are reflected in the claims listing above via amendments to existing claims or addition of new claims submitted herewith.

No particular agreement was reached during this interview.

35 U.S.C. § 103 Rejections

Claims 1, 4-16 and 19-27

The Examiner has rejected claims 1, 4, 5, 10, 12, 13, 17, 19 and 20-26 under 35 U.S.C. §103(a) as being allegedly unpatentable over Berarducci, et al. (U.S. Pub. No.: 2005/0225799), herein after "Berarducci", in view of Reed, et al. (U.S. Pub. No.: 2005/0004978) herein after "Reed", Mauro, et al. (U.S. Pub. No.: 2003/0200099), herein after "Mauro", and von Rosen, et al. (U.S. Pub. No.: 2003/0069809), herein after "von Rosen". Applicant respectfully disagrees.

I. The cited references do not disclose all the subject matter in the independent claim 1

Applicant respectfully submits that when viewed as a whole, the cited references do not show the subject matter recited in the pending claims.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).”

Applicant respectfully submits that the combination of Berarducci, Reed, Mauro, and Rosen do not render obvious applicants independent claims since when viewed individually or as a whole, Berarducci, Reed, Mauro, and Rosen do not disclose each and every element of independent claim 1.

Reference 'Beraducci'

Beraducci discusses a method of transferring images captured by a digital capture device to a remote memory location over a channel. The Beraducci method also includes providing a plurality of user selectable times for the transfer of images over the channel from the local memory to the remote memory location (Abstract, Beraducci). The user can establish a service account and select the type of photo products that they prefer. The user can also select the images to be uploaded, and a preferred upload time option.

However, Beraducci does not discuss, motivate, or teach, "generating a user provisioner comprising a set of settings for the identified user based on at least one of a profile aspect, a personalization aspect, and a customization aspect, wherein ... said personalization aspect includes a set of predetermined user-selected image processing settings" and "associating the user provisioner with a processing and fulfillment request" when a user request is received, as claimed in claim 1.

Applicant submits that Beraducci does not make the distinction of having "a set of predetermined user-selected image processing settings for modification of the digital image" since in Beraducci, the photo modification options are selected when a request for fulfillment is being placed. Even though in Beraducci, a user service account is established, the information stored about the user only includes customer name, delivery, and billing information and has no memory of choices/options made.

For example, in Beraducci:

In block 104, a user service account is established for the customer. The information stored in the service account includes the information entered by the customer in block 102 (e.g., name, password, delivery, and billing information). This service account information will later be augmented by additional information listing the photo product options selected by the customer ... (Page 3, par [0040])

Therefore, Beraducci does not generate a user provisioner that includes predetermined user-selected image processing settings, as claimed by applicant.

Furthermore, in the system of Beraducci the image customization settings can only be provided when the request is being placed. The image processing settings are "later augmented" in the service account information when provided by the user during the ordering process.

For example, in Beraducci:

In block 106, the fulfillment center 40 provides the customer with a menu of photo products 66 that are available for customization ... (Page 3, par [0041])

In block 110, the network server 42 provides a menu of customizable features for the type of products selected by the user ... (Page 3, par [0042])

Thus, Beraducci also does not teach, suggest, or motivate, the teachings of "associating the user provisioner with a processing and fulfillment request" when a user request is received, as claimed in claim 1 since in Beraducci, the image processing settings can only be specified by a user when the order is being placed with the fulfillment request.

Neither Reed, nor Mauro, nor Rosen cures the deficiency.

Reference 'Reed'

Reed was cited for alternate subject matter recited in the previously pending claims and does not cure the deficiency of Beraducci.

Specifically, Reed describes a computer implemented method for on-line purchasing via the global Internet where customer data usable to automatically complete an on-line purchase by the customer of an item from a seller is received and stored at a node connected to the Internet (Abstract). Reed, however, does not include at least the recited subject matter of "generating a user provisioner comprising a set of settings for the identified user based on at least one of a profile aspect, a personalization aspect, and a customization aspect, wherein ... said personalization aspect includes a set of predetermined user-selected image processing settings" and "associating the user provisioner with a processing and fulfillment request" when a user request is received, as claimed in claim 1.

Thus, even if Beraducci and Reed were combined, the resulting disclosure would be different from what is claimed by the applicant in claim 1. The combination would not include

the claimed subject matter of, "generating a user provisioner comprising a set of settings for the identified user based on at least one of a profile aspect, a personalization aspect, and a customization aspect, wherein ... said personalization aspect includes a set of predetermined user-selected image processing settings for modification of a digital image " and "associating the user provisioner with a processing and fulfillment request" as claimed by applicant. Thus, without admitting to the propriety of combining Beraducci and Reed in a way presented in the Office Action, Applicant submits that independent claim 1 is patentable over Beraducci, Reed, and over the combination of Beraducci and Reed, at least for the above stated reasons.

Reference 'Mauro'

Mauro was cited for alternate subject matter recited in the previously pending claims and does not cure the deficiency of Beraducci.

Specifically, Mauro describes a method and system for providing imaging services to a digital order (Title).

Although Mauro describe the concept of a "default customer profile" that is encoded on an adhesive label, the information included in the "default customer profile" does not include "predetermined selected image processing settings for modification of a digital image", as claimed in claim 1. Mauro's "default customer profile" is limited to specifying customer preferred photofinishing services and billing information.

For example, in Mauro:

The default customer profile would comprise a default photofinishing service that would be provided to the user ... (Page 2, par [0018])

As a further option, in addition to the default customer profile that indicates that, for example, the customer prefers 4x6 double prints ... (Page 3, par [0021])

Note that although the default customer profile specifies finishing specifications (e.g., 4x6 double prints), Mauro does not specify that the default customer profile includes "predetermined selected image processing settings for modification of a digital image", as claimed by applicant.

Thus, Mauro also does not include at least the recited subject matter of "generating a user provisioner comprising a set of settings for the identified user based on at least one of a profile aspect, a personalization aspect, and a customization aspect, wherein ... said personalization aspect includes a set of predetermined user-selected image processing settings for modification of a digital image" and "associating the user provisioner with a processing and fulfillment request" when a user request is received, as recited in claim 1.

Thus, even if Beraducci, Reed, and Mauro were combined, the resulting disclosure would be different from what is claimed by the applicant in claim 1. The combination would not include the claimed subject matter of, "generating a user provisioner comprising a set of settings for the identified user based on at least one of a profile aspect, a personalization aspect, and a customization aspect, wherein ... said personalization aspect includes a set of predetermined user-selected image processing settings for modification of a digital image" and "associating the user provisioner with a processing and fulfillment request" as claimed by applicant. Thus, without admitting to the propriety of combining Beraducci, Reed, and Mauro in a way presented in the Office Action, Applicant submits that independent claim 1 is patentable over Beraducci, Reed, and Mauro, and over the combination of Beraducci, Reed, and Mauro, at least for the above stated reasons.

Reference 'von Rosen'

von Rosen was cited for alternate subject matter recited in the previously pending claims and does not cure the deficiency of Beraducci.

Specifically, von Rosen describes a method and apparatus for creating and ordering customized branded merchandise over a computer network (Title) and also does not include at least the recited subject matter of "generating a user provisioner comprising a set of settings for the identified user based on at least one of a profile aspect, a personalization aspect, and a customization aspect, wherein ... said personalization aspect includes a set of predetermined user-selected image processing settings for modification of a digital image" and "associating the user provisioner with a processing and fulfillment request" when a user request is received, as recited in claim 1.

Thus, even if Beraducci, Reed, Mauro, and von Rosen were combined, the resulting disclosure would be different from what is claimed by the applicant in claim 1. The combination would not include the claimed subject matter of, "generating a user provisioner comprising a set of settings for the identified user based on at least one of a profile aspect, a personalization aspect, and a customization aspect, wherein ... said personalization aspect includes a set of predetermined user-selected image processing settings for modification of a digital image" and "associating the user provisioner with a processing and fulfillment request" as claimed by applicant. Thus, without admitting to the propriety of combining Beraducci, Reed, Mauro, and von Rosen in a way presented in the Office Action, Applicant submits that independent claim 1 is patentable over Bera Beraducci, Reed, Mauro, and von Rosen, and over the combination of Beraducci, Reed, Mauro, and von Rosen, at least for the above stated reasons.

Thus, applicant submits that at least for the above stated reasons, the independent claim 1 is patentable over Beraducci, Reed, Mauro, von Rosen, and the alleged combination of Beraducci, Reed, Mauro, and von Rosen, without admitting to the propriety of combining Beraducci, Reed, Mauro, and von Rosen.

Thus, at least for the above stated reasons, the withdrawal of the rejection for the independent claim 1 is respectfully requested.

Dependent Claims

The Examiner has rejected dependent claims 6-8 under 35 U.S.C. §103(a) as being allegedly unpatentable over Berarducci, Reed, Mauro, and Rosen as applied to claim 1 in the office action and further in view of Ramachandran, et al. (US Pub. No.: 2001/0044747). Applicant respectfully disagrees.

The Examiner has rejected dependent claim 9 under 35 U.S.C. §103(a) as being allegedly unpatentable over Berarducci, Reed, Mauro, and Rosen as applied to claim 1 in the office action and further in view of House, et al. (US 2003/0229536). Applicant respectfully disagrees.

The Examiner has rejected dependent claims 11, 14, 15, 27 and 28 under 35 U.S.C. §103(a) as being allegedly unpatentable over Berarducci, Reed, Mauro, and Rosen as applied to claim 1 in the office action and further in view of Paul (US Pub. No.: 2004/0171371). Applicant respectfully disagrees.

The Examiner has rejected dependent claims 11, 14, 15, 27 and 28 under 35 U.S.C. §103(a) as being allegedly unpatentable over Berarducci, Reed, Mauro, and Rosen as applied to claim 1 in the office action and further in view of Chauvin, et al. (US Pub. No.: 2003/0038882). Applicant respectfully disagrees.

In view of the above remarks, a specific discussion of the dependent claims is considered to be unnecessary. Therefore, applicant's silence regarding any dependent claim is not to be interpreted as agreement with, or acquiescence to, the rejection of such claim or as waiving any argument regarding that claim. Therefore, the remaining dependent claims are also patentable over the cited references at least for the above stated reasons. The withdrawal of the rejections under 35 U.S.C. §103(a) is respectfully requested for claims 4-27.

CONCLUSION


In light of the amendments and the preceding arguments, the applicant respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance.

If the Examiner believes that a conference would be of value in expediting the prosecution of this application, he is cordially invited to telephone the undersigned counsel at (650) 838-4306 to arrange for such a conference.

No fees are believed to be due, however, the Commissioner is authorized to charge any underpayment in fees to Deposit Account No. 50-2207.

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Respectfully submitted,

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